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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/341,009	08/25/99	WU	VB 9555.94USWO

HM22/0308  
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EXAMINER
LUKTON, D

ART UNIT	PAPER NUMBER
1653	S

DATE MAILED: 03/08/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/341,009

Applicant(s)

Wu

Examiner

David Lukton

Group Art Unit

1653



☒ Responsive to communication(s) filed on Oct 15, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 30 DAYS (months), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-20 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Pursuant to preliminary amendment, claims 5-8, 13, 20 have been amended to correct claim dependence.

\*

Restriction to one of the following inventions is required under 35 U.S.C. §121:

- I. Claims 1-9, drawn to a composition for reversing an immune response, classified in, e.g., 514/19.
- II. Claims 10-13, drawn to a composition for disrupting mitochondrial function, classified in, e.g., 514/19.
- III. Claims 14-17, drawn to a composition for disrupting NO synthesis, classified in, e.g., 514/19.
- IV. Claims 18-20, drawn to a screening method, classified in, e.g., 435/004.

The claimed inventions are distinct. Each of Groups 1-3 could be interpreted to refer to a different genus of proteasome inhibitors.

It is acknowledged that this is a national stage application filed under 371 provisions. However, this does not mean that lack of unity cannot be declared. First, PCT rules do not mandate that a screening method be examined in the same application as compounds or compositions. More importantly, unity is lacking because none of Groups I-III "defines a contribution" over the art. As it happens, proteasome inhibitors are were known prior

to 10/31/97. [If applicants believe that they are the first to discover proteasome inhibitors, a reference will be provided which shows this not to be the case]. Notwithstanding the foregoing, in the event that applicants elect one of Groups I-III, and the claims therein are found allowable, the possibility of rejoining one or more of the non-elected groups will be considered.

Applicant is advised that for the response to this requirement to be complete, an election of the invention to be examined must be indicated, even if the requirement is traversed (37 C.F.R. 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

. . . .

In addition to the foregoing, applicants are required under 35 U.S.C. §121 to elect disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. In the event that one of Groups I-III is selected, election of a specific proteasome inhibitor is required. In the event that Group I is selected, a second species election is required, specifically an immunosuppressive drug such as cyclosporin A.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.

Serial No. 341,009  
Art Unit 1653

-4-

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



**DAVID LUKTON  
PATENT EXAMINER  
GROUP 1800**